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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,259	06/05/2001	Teruo Tanaka	NIT-278	5965
24956 7590 03/03/2009 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
EXAMINER CHENCINSKI, SIEGFRIED E				
ART UNIT 3695		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/873,259

**Applicant(s)**

TANAKA ET AL.

**Examiner**

SIEGFRIED E. CHENCINSKI

**Art Unit**

3695

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 & 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1, 3 & 4 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman (US Patent 5,826,244) in view of Kinney et al. (US Patent 7,249,085 B1, hereafter Kinney), Shoham et al. (US Patent 6, 285,989, hereafter Shoham), Odom et al. (US Patent 6,058,379, hereafter Odom) and Koopersmith (US Pregrant Publication 2001/0042002 A1).

**Re. Claim 1**, Huberman discloses a method for an auction brokerage service provided by a computer that resides between an information terminal of a user and auction servers to perform brokerage operation for an auction. Huberman also discloses a computer automated third party broker service for administering an auction process between sellers and prospective customers (Abstract, ll. 1-2). Huberman further discloses multiple auctions (Col. 7, ll. 12-15; Col. 18, ll. 38-41) and communicating with the customer's user information terminal to notify of the auction result information (Col. 3, l. 59 – Col. 4, l. 18).

Huberman does not explicitly disclose a method for:

- Selecting information of said auction servers suitable for the user's conditions from among stored information related to said auction servers, in response to a request from said information terminal;
- Transmitting an auction registration request in the name of the user to each of the auction servers at the auction sites, that have been selected by the user from among the selected auction servers at the selected auction sites to receive a notification that the an auctioned commodity of the user has been registered at

the selected auction servers, the selected auction servers auctioning the auctioned commodity simultaneously at the selected auction sites to the plurality of buyers accessing the selected auction sites;

- Notifying said information terminal of the auction result information and outputting the auction result, wherein said auction servers are other brokerage computers which accept bids from a plurality of information terminals for the auctioned commodity.

However, Kinney discloses "enabling each individual bidder to view a comparison of submitted bids in their own context" (Abstract, ll. 7-9), i.e. each bidder sees the other bids in real time.

Shoham discloses "multiple auctions simultaneously" (Col. 12, ll. 28-29), and the notification of the participant of the progress of a bid (Col. 14, ll. 11-16; Col. 14, l. 65 – Col. 15, l. 8; Col. 15, ll. 14-20).

Odom discloses multiple concurrent auctions (Col. 10, l. 10; Col. 10, l. 37 – Col. 11, l. 9). A preferred embodiment disclosed is in the trading of SEC listed stocks (i.e. registered equities). This auction activity is taking place during normal business hours simultaneously with auctioning of the same securities on one or more exchanges.

Koopersmith discloses a search server searching a data base of web site addresses for web sites fitting a certain word definition. Such a search is likely to bring up a number of qualified web sites, which are essentially contained in a server. Koopersmith's example illustrates a search for suppliers of toasters (page 1, [0004]-ll. 8-16). It would have been obvious to the practitioner that a similar automated search would have located servers which offer commodity auction servers which meet the seller's commodity criteria.

Selecting information of said auction servers suitable for the user's conditions from among stored information related to said auction servers, in response to a request from said information terminal is implicit in Kinney, Shoham and Odom.

Transmitting an auction registration request in the name of the user to each of the auction servers that have been selected by the user from among the selected auction servers to receive a notification that an auctioned commodity of the user has been registered at the auction servers is also implicit in Huberman, Kinney, Shoham and

Odom because the users implicitly are making these selections through their participation and approval. Registration of a user is implicit in each auction reference such as in Huberman and Shoham. It is obvious that registration information is transmitted by the intermediary on behalf of the user to each auction related entity as needed since this is part of the intermediary's service to benefit the user. It is also obvious that the intermediary is acting in the name of the user.

Regarding the most recent additions to the claim by amendment, the ordinary practitioner of the art at the time of Applicant's invention would have found it obvious that servers would be at the auction sites selected by the user, that commodities being auctioned would be registered at the selected auction servers, and, from Shoham above, that selectee items could be auctioned simultaneously at the selected auction servers. Hence, the disclosures by Huberman Kinney, Shoham, Odom and Koopersmith, combined with the well known practices cited above, would have made it obvious to the ordinary practitioner to

- Selecting information of said auction servers suitable for the user's conditions from among stored information related to said auction servers, in response to a request from said information terminal;
- Transmitting an auction registration request in the name of the user to each of the auction servers at the auction sites, that have been selected by the user from among the selected auction servers at the selected auction sites to receive a notification that the auctioned commodity of the user has been registered at the selected auction servers, the selected auction servers auctioning the auctioned commodity simultaneously at the selected auction sites to the plurality of buyers accessing the selected auction sites;
- Receiving auction result information from the selected auction servers;
- Notifying said information terminal of the auction result information and outputting the auction result, wherein said auction servers are other brokerage computers which accept bids from a plurality of information terminals for the auctioned commodity.

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Neither Huberman, Kinney, Shoham, Odom, or Koopersmith explicitly disclose a method for auction brokerage service further comprising a step of gathering trade information of how the auctioned commodity has been bid for at the selected auction servers and notifying the other selected auction servers and notifying the other selected auction sites of the highest tendered price of the bids in order to adjust the bid prices to the highest price over all the selected auction sites. However, Applicant has chosen to define the notification step in the specification as meaning the option of "Specifically, the auction site monitoring section 242 may place .... Or it may alter the lower limit of the desired price of such commodity into the highest tendered price in the name of the user" (Specification, page 15, ll. 13-23). The option of changing an offer price such as the minimum acceptable price in an auction was well known at the time of Applicant's invention. This well known and well established practice not only has a basis as an old practice prior to the consummation of a transaction, but it is also embedded in US law. An offer may be changed or withdrawn at any time before it is legally accepted. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Kinney, Shoham, Odom, Koopersmith and well known practices for the purpose of gathering trade information of how the auctioned commodity has been bid for at the selected auction servers and notifying the other selected auction servers and notifying the other selected auction sites of the highest tendered price of the bids in order to adjust the bid prices to the highest price over all the auction sites. As a result, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Kinney, Shoham, Odom and Koopersmith and well known practices for the purpose of providing computer automated third party multi auction brokerage services for a client through a computer link, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claim 3,** neither Huberman, Kinney, Shoham, Odom, or Koopersmith explicitly disclose a step of requesting the selected auction servers to alter the desired price

specified by the user according to the user's instruction when the computer has found that there is no bid for the commodity at any relevant auction sites by the date specified by the user. The practice of changing an offer price such as by reducing the offer price when there have been no offers at a given price was well known in the art of auctions and in the basic selling art in cases when an item was confirmed to have been legitimately exposed to prospective buyers ("where the commodity had been registered (in an auction) by the date specified by the user"). Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Kinney, Shoham, Odom, Koopersmith and well known practices for the purpose of operating a method for an auction brokerage service, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claim 4**, neither Huberman, Kinney, Shoham, Odom, or Koopersmith explicitly disclose a method for notifying the other auction sites of canceling the registration of the commodity by an auction site with which the trade has concluded. Removing an item from being offered for sale after a sale has been made is a logical step to take, and was a well established practice in the art at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Kinney, Shoham, Odom, Koopersmith and well known practices for the purpose of notifying the other auction sites of canceling the registration of the commodity by an auction site with which the trade has concluded, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**2. Claims 5-10 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman in view of Kinney, Shoham, Odom and Koopersmith

**Re. Claims 5 & 8**, Huberman does not explicitly disclose the detailed specifics of a method and a computer used in executing by a brokerage computer residing between a

user computer of an auction user and auction computers of auction organizers to perform brokerage operations for auctions, the method and system comprising steps of:

- (a) receiving information about the auctioned commodity and at least one specified auction organizer from the user computer;
- (b) sending the information about the auctioned commodity in the name of the user to the auction computers of the specified auction organizers, the auction computers auctioning the auctioned commodity simultaneously to the plurality of buyers accessing the specified auction organizers;
- (c) gathering trade information of how the auctioned commodity has been bid for at the specified auction organizers;
- (d) tendering the other auction computers of the highest bid price of the bid prices in the name of a substitute in order to adjust the bid prices to the highest price over all the auction computers; and
- (e) taking an action in accordance with conditions specified by the user computer if the brokerage computer has found that there is not bid for the commodity at any auction computers by the date specified by the user including notifying said user computer of the auction result information and outputting the auction result, wherein said auction computers are other brokerage computers which accept bids from a plurality of other computers for the auctioned commodity.

However, at the time of Applicant's invention, please refer to the rejection of claim 1 for rejection background fundamentals regarding a method executed by a brokerage computer residing between a user computer of an auction user and auction computers of auction organizers to perform brokerage operations for auctions. Further,

- (1) Use of third party service providers or brokers performed through computer automated methods and means was well known (Huberman, Col. 1, ll. 35-40).
- (2) Offering of commodities on multiple parallel auction services was well known (See the rejection of claim 1).
- (3) The various tasks to be performed by a third party service provider for a customer within the scope of the assignment, including communications tasks and other steps, was implicit and obvious to the performance of a third party service.



(4) It also was obvious that auction organizers and the web sites and web servers they are using are interchangeable to a user in such auctions since the web sites and related servers are merely inert apparatus which operate according to the programming instructions of their organizers and the operators who may be working in their employ. Thus, the auction sites represent their organizers and can be considered interchangeable for purposes of the limitations in these claimed inventions..

In this case, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Huberman with Kinney, Shoham, Odom and Koopersmith for the purpose of providing the service of an auction brokerage operation for a user customer, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claims 6 & 9,** Huberman does not explicitly disclose the detailed specifics of a method and means for execution comprising a step of requesting the auction organizers to alter the desired price specified by the user according to the instruction of the auction user if no bid has been found by the specified date. See the rejection of claim 5 regarding auction organizers. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of alternation of the desired price according to the instruction of the auction user if no buyer has been found for said auctioned commodity at all of said auction organizers by the date specified by the auction user for the reasons stated in the rejection of claim 3. Therefore, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Huberman with the disclosures of Huberman with Kinney, Shoham, Odom and Koopersmith for the purpose of requesting the auction sites to alter the desired price specified by the user according to the instruction of the auction user if no bid has been found by the specified date, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claims 7 & 10**, Huberman does not explicitly disclose the detailed specifics of a method comprising a step of notifying the other auction sites of canceling the registration of the commodity but an auction site with which the trade has concluded. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of cancellation of registration when any buyer has been found at any of said auction organizers and the auction is terminated for the reasons stated in the rejection of claim 4, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

### ***Response to Arguments***

3. Applicant's arguments received on December 11, 2008 regarding claims 1 and 3-10 have been fully considered they are moot in view of the new basis of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

March 2, 2009

/Narayanswamy Subramanian/

Primary Examiner, Art Unit 3695